

JEAN VUARNET,)	INTER PARTES CASE NO. 3454
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 60673
)	Filed : January 7, 1987
)	Applicant : Claro C. Pablo
)	Trademark : VUARNET & V LOGO
- versus -)	Used on : T-shirts and shorts
)	
)	<u>DECISION NO. 92-29 (TM)</u>
)	
CLARO C. PABLO)	November 13, 1992
Respondent-Applicant.)	
x-----x)	

DECISION

On October 30, 1989, Jean Vuarnet, a citizen of France, with principal Office and place of business at 151 E route la Capite, 1222 Vesenz, Geneve, Suisse, filed her Verified Notice of Opposition for the registration of the mark "VUARNET & V LOGO" bearing Serial No. 60673 used on t-shirts and shorts which application was filed on January 7, 1987 by CLARO C. PABLO of 500-G Shaw Boulevard, Mandaluyong, Metro Manila in which, said application was published on page 20, Volume 11, No. 6 of the Official Gazette of the BPTTT on June 30, 1989.

The grounds of the opposition are as follows:

1. The registration of the trademark "VUARNET & V LOGO" in the name of respondent-applicant will cause confusion or the likelihood of confusion as to the goods themselves or to their source of origin, or will mislead the purchasing public and make it convenient for respondent-applicant to pass off his goods as those of the opposer, resulting in damage to both the public and the opposer;
2. Except for the V Logo which is an attempt by respondent-applicant to camouflage his illegal appropriation of opposer' mark, the trademark "VUARNET & V LOGO" is confusingly similar to the trademark "VUARNET" owned and being used by the Opposer, such that the registration of the trademark "VUARNET & V LOGO" in the name of respondent-applicant will run counter to SECTION 4(d) of R.A. No. 166, as amended;
3. The registration of the trademark "VUARNET & V LOGO" in the name of respondent-applicant will violate the proprietary rights and interests of the opposer over his trademark "VUARNET" and will therefore cause great and irreparable injury to the latter."

The Opposer relies on the following facts:

1. The Opposer is the registered owner of the mark "VUARNET", the application for which registration was originally filed by its assignor, Sporoptic Pouilloux, S.A. on November 12, 1984 with the Bureau of Patents, Trademarks and Technology Transfer which has issued Certificate of Registration No. 43251, February 24, 1989. Opposer's trademark is also part of his name or business and goods particularly eyeglasses, especially for skiing, sailing and mountain climbing, lenses, and optical glass under International Class 9. Opposer is also

intending to expand his business to products related to such goods, like sports clothing;

2. The Opposer and/or thru his predecessor, Sporoptic Pouilloux S.A. has been using the trademark "VUARNET" on his goods in several countries including the Philippines for many years and long before the respondent-applicant allegedly commenced using the trademark "VUARNET & V LOGO" in the Philippine upon t-shirts and shorts;
3. The Opposer caused the promotion, advertising and popularization of his trademark "VUARNET" worldwide;
4. The long use of, as well as popularization of the trademark "VUARNET" has generated an immense goodwill for the same not only in France, but in various countries all over the world, including the Philippines, such that said trademark has acquired general international consumer recognition as belonging to the owner, herein opposer. Opposer has registered the trademark "VUARNET" in a number of countries;
5. The trademark "VUARNET & V LOGO" is but a plain and true imitation of Opposer's trademark "VUARNET", VUARNET, being the dominant component or feature of "VUARNET & V LOGO" so that its use on the goods of respondent-applicant would infer that respondent-applicant's goods are the goods of, or connected with the goods manufactured and/or sold by herein opposer as to falsely suggest a connection with the existing business of opposer and therefore constitute an intent to defraud opposer and the consuming public;
6. The use of the trademark "VUARNET & V LOGO" on respondent-applicant's goods will prevent opposer from expanding his business to sportswear, such as t-shirts, shorts, etc. and will likewise diminish the distinctiveness or strength of said trademark which the opposer's goods to prejudice and in violation of opposer's rights to said trademark;
7. The adoption of the trademark "VUARNET & V LOGO" was obviously intended by respondent-applicant to ride on the goodwill of opposer's trademark."

The main issue to be resolved in this case is:

WHETHER OR NOT THE TRADEMARK OF RESPONDENT-APPLICANT "VUARNET & V LOGO" IS CONFUSINGLY SIMILAR WITH THE OPPOSER'S TRADEMARK "VUARNET", AND IF REGISTERED IN THE NAME OF RESPONDENT-APPLICANT WOULD NOT RUN COUNTER TO THE PROVISIONS OF SECTION 4(D) OF R.A. NO. 166, AS AMENDED WHICH READS AS FOLLOWS, TO WIT:

"SEC. 4 (d). Consists of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers."

The quoted provision set forth the rule that one cannot register in the Principal Register a trademark which so resembles the trademark registered in the Philippines or previously used therein by another and not abandoned as to likely cause confusion, mistake or deception on the part of the purchasers.

On March 12, 1991, Opposer, in compliance with Order No. 91-98 dated February 1, 1991, filed an Affidavit of publication pursuant to Sec. 21, Rule 14 of the Rules of Court. After the publication in a newspaper of general circulation, Respondent has not filed any responsive pleadings to the said Notice to Answer, hence, he was MOTU PROPRIO declared in default pursuant to Rule 169-c of the Rules of Practice in Trademark Cases (Order No. 91-292) dated March 21, 1991.

Opposer on September 11, 1991, presented his evidence ex-parte consisting of Exhibits "A" to "BBB" and their corresponding submarkings.

On February 24, 1989, the trademark "VUARNET" was registered with the Bureau of Patents, Trademarks and Technology Transfer bearing Registration No. 43251 in the name of the Assignee the herein Opposer MR. JEAN VUARNET (Exhibit "B", "B-1" and "B-2"). Under Section 20 of R.A. 166, as amended, the certificate of registration constitutes prima facie evidence of the validity of the registration, the registrant's ownership of the mark and the exclusive right to use the same in connection with his goods business or services specified in the certificate, subject to any conditions and limitations stated therein.

Likewise the trademark "VUARNET" is part of the name of the herein Opposer and has been used in his business and on his products (Exhibits "A-1").

Moreover, Opposer's trademark "VUARNET" has been registered in many countries of the world such as France, South Africa, Mexico, Argentina, Britain, Switzerland, Japan, Sweden, U.S.A., Spain, Australia, Brazil, Chile, Korea, Hongkong, India, Indonesia, Malaysia, Taiwan, and Thailand, therefore, Opposer deserves protection under Article 6bis of the Paris Convention as a well-known mark.

On the basis of the evidence presented, Respondent-Applicant's trademark "VUARNET & V LOGO" is identical to Opposer's trademark "VUARNET" as both marks contained the same word, and they are the same in spelling and pronunciation. Further, the goods or products covered by the competing marks are the same, hence, there is no doubt that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark.

In connection with the use of a confusingly similar or identical mark, both foreign authority and our Supreme Court on several occasions ruled, thus:

"Thus who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals etc. as to justify on one who really wishes to distinguish his products from those of all others entering the twilight zone of a filed already appropriated by another." (WECO Products Co. vs. Milton Ray Co., 143 F. 2d 985, 32 c.c.p.a. Patents 1214.)

Why of the million of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark (American Wire and Cable Co. vs. Director of Patents, 31 SCRA 544).

Why, with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (Manila Candy Co.) elected two roosters as its trademark, although its directors and managers must have been well aware of the long-continued use of a rooster by the plaintiff with the sale and achievement of its goods? xxx a cat, a dog, a carabao, a shark or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for purposes of identification as the product of defendant's

factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co. 36 Phil. 100).

WHEREFORE, premises considered, the herein Notice of Opposition is hereby GRANTED. Accordingly, Application Serial No. 60673 for the trademark "VUARNET & V LOGO" filed on January 7, 1987 by Claro C. Pablo is hereby REJECTED.

Let a filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished to the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director